

REMARKS

This application was originally filed on 28 December 2001 with thirty-two claims, two of which were written in independent form. Claims 21 and 22 were canceled, and Claims 1, 17, and 18 amended on 27 October 2003. Claims 1-17 have been amended herein to clarify what is being claimed. No claims have been allowed.

Claims 1-20 and 23-32 were objected to for a variety of informalities. Claims 1-17 have been amended to overcome this objection. Specifically, Claims 1 and 17 were amended to recite "a total internal reflection prism assembly" as suggested by the Examiner, Claim 1 was amended to clarify the relationship between the TIR prism assembly and the other claim limitations, and Claims 2-16 were amended to recite a "display system" as recited by Claim 1.

Claims 1 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,552,840 to Ishii *et al.* ("Ishii") in view of U.S. Patent No. 5,892,232 to Budd *et al.* ("Budd"). The applicant respectfully disagrees and submits the Examiner has failed to present a *prima facie* case of obviousness.

"To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

The Examiner has the duty to present a *prima facie* obviousness rejection. The Examiner has not pointed to any teaching in the prior art suggesting the combination proposed by the Examiner. Instead, the Examiner merely states, "It would have been obvious to one of ordinary skill in the art at the time of the invention to use the total internal reflection prism of Budd *et al.* in the image display system if Ishii *et al.* in order to make the image display system more compact light weight, efficient, and low cost," citing lines 51-52 in column 9 of Budd.

The system of Ishii and the system of Budd do not appear to be properly combinable under the patent laws and for a variety of technical reasons.

Ishii teaches a three dimensional projection display system using two LCD modulators and a polarizing beam splitter. Budd teaches the use of a polarizing beam splitter that is

compact, light weight, efficient, and low cost. Budd's system uses a "strip-PBS array 100 [that] enables the unpolarized light 145 to emerge normal to the other surface, e.g. the exit surface 120, as a polarized light 150" (lines 19-22 of column 5). As shown in Figure 3, Budd accomplishes this by passing the white light through two segments of the polarizing beam splitter and a half-wave retardation layer 135.

As the light exiting Budd's polarizing beam splitter is polarized, it is not clear how it could be adapted to function in Ishii's system which uses the polarizing beam splitter to separate and emit two separately polarized beams of light, one for each modulator.

Not only is it unclear how the two systems could be combined into a functioning system, it also appears the combination if it could be made to work would not achieve any of the advantages touted by the Examiner as compared to either of the two systems separately.

As the Examiner has failed to show how the two systems could be combined technically into a single functioning system, much less an express or implied suggestion in the art to make such combination or modification, and does not provide any line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references as required by Ex Parte Clapp, but rather appears to merely have used the applicants own claim as a shopping list to combine elements from the prior art, the Examiner has not met the burden of presenting a prima facie case of obviousness. Therefore, the rejection under 35 U.S.C. § 103(a) is defective and should be withdrawn.

Claims 2, 3, 5-7, 12, 16, 18, 19, 23, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Budd. Claims 4 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Budd and further in view of U.S. Patent No. 6,285,415 to Brennessoltz. Claims 8-11 and 24-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Budd and further in view of U.S. Patent Publication No. 2003/0020809 to Gibbon *et al.* Claims 13 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Budd and further in view of U.S. Patent No. 6,097,456 to Wang.

Claims 2-16 depend from Claim 1 and should be deemed allowable for that reason and on their own merits. Claims 18-20 and 23-32 depend from Claim 17 and should be deemed

allowable for that reason and on their own merits. For the reasons cited above with respect to Claims 1 and 17, the prior art does not show, teach, or suggest the combination of limitations recited by Claims 1 and 17, much less the limitations of Claims 1 and 17 in combination with the additional limitations of the dependent claims.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the pending claims are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



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Amendment - Page 10